

REMARKS

Claims 1-47 and 49-65 are presently pending in the application. Claim 26 has been amended in this response to correct a typographical error. This amendment does not narrow the scope of the claim and is not made for reasons related to patentability.

In the Office Action mailed February 28, 2006, claims 1-47 and 49-65 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 1-7, 11, 14, 16-18, 20-23, 26, 27, 29-32, 34-40, 43-45, 49, 51-54, 57-59 and 61-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,173,274 to Ryan ("Ryan") in view of U.S. Patent No. 5,938,036 to Villemure ("Villemure");

(B) Claims 8, 9, 24, 28, 42 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Villemure and U.S. Patent No. 5,473,863 to Itkonen ("Itkonen");

(C) Claims 10, 25, 33, 41, 55, 60 and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Villemure and U.S. Patent No. 5,035,515 to Crossman et al. ("Crossman"); and

(D) Claims 12, 13, 15, 19, 46, 47 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Villemure and U.S. Patent No. 6,421,652 to Loeb et al. ("Loeb").

A. Response to the Section 103(a) Rejection Over Ryan and Villemure

Claims 1-7, 11, 14, 16-18, 20-23, 26, 27, 29-32, 34-40, 43-45, 49, 51-54, 57-59 and 61-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan in view of Villemure. As set forth in detail below, Ryan and Villemure cannot support a Section 103(a) rejection of these claims because (a) these reference, alone and in combination, fail

to disclose or suggest all the features these claims, and (b) there is no motivation to combine these references.

1. Claim 1 is Directed to a Computer System for Processing a Paper Product Including a Promotions Order Tracker Configured to Receive a Promotional Material Order From a Third-Party Advertiser to Place Promotional Material on an Enclosure for the Paper Product

Claim 1 is directed to a computer system for processing a paper product. The computer system includes a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer. The paper product includes a roll of paper or a plurality of unbound, stacked paper sheets. The computer system further includes a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product. The computer system also includes a paper product tracker configured to provide instructions for creating the enclosure for the paper product. The enclosure has the promotional material of the received promotional material order. The paper product tracker is also configured to provide instructions to enclose the paper product of the received order with the created enclosure. The paper manufacturer, the paper purchaser, and the third-party advertiser are different entities. The third-party advertiser pays to have the promotional material placed on the enclosure of the paper product.

2. Ryan Discloses a Production Mail System for Printing Advertisements on Envelopes Addressed to a Specific Targeted Audience

Ryan discloses a production mail system for printing advertisements on envelopes addressed to a specific targeted audience. The mail system includes a data processing system with user profiles, an advertiser database, and an address demographics database. The user profiles enable each user to set parameters for controlling third-party advertising on their respective envelopes. For example, each user profile includes an indication of whether the user allows third-party advertising and, if so, a list of preferred third-party advertisers. The advertiser database includes restriction data with information

about the targeted audience. For example, the restriction data may include information related to the income, age, education level, marital status, and/or ethnicity of the targeted audience. The address demographics database includes demographic information for various geographic regions of the country.

During operation, the user submits a mailing list to the data processing system for processing. The mailing list includes multiple recipient addresses to which the user wishes to send mail pieces. The data processing system reviews the mailing list and determines which recipients can have advertisements printed on their envelopes. The data processing system also selects advertisements for each specific recipient based on the advertiser's restriction data, the recipient's address, and the demographic information in the address demographics database. As a result, a specific advertisement is printed on each envelope to ensure that the advertisements are sent to the advertiser's targeted audience.

3. Villemure Discloses a Tower of Packaged Reams in Which the Reams are Attached Together with an Adhesive that is Sprayed on the Upper Face of the Paper Wrapping

Villemure discloses a tower of packaged reams stacked on a pallet. Each ream includes a multiplicity of paper sheets and a paper wrapping enclosing the sheets. An adhesive is sprayed on the upper face of the individual paper wrappings to adhere each ream to an adjacent ream in the tower. At the point of sale, a tubular sleeve can be slid over the tower of stacked reams. The tubular sleeve has a removable panel to expose the packaged reams at one side of the tower.

4. Ryan and Villemure Fail to Disclose or Suggest a Computer System for Processing a Paper Product Including a Promotions Order Tracker Configured to Receive a Promotional Material Order from a Third-Party Advertiser to Place Promotional Material on an Enclosure for the Paper Product

Ryan and Villemure fail to disclose or suggest a computer system including, *inter alia*, "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product"

in which the paper product includes "a roll of paper or a plurality of unbound, stacked paper sheets," as recited in claim 1. In the Office Action, the Examiner asserts:

Villemure teaches a paper manufacturer that assemblies [sic] packaged reams of paper sheets and where said reams of paper sheet provides a display surface for information and advertising which can be personalized for particular users or distributors (see Villemure column 5, lines 54-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to know that Villemure's paper manufacturers would be motivated to include promotions into paper product package wrappers in view that third party advertisers would pay said manufacturers for including advertisements into said wrappers, as taught by Ryan.

(Office Action, page 3.) Applicant respectfully disagrees. As set forth below, Villemure does not disclose reams with "a display surface for information and advertising," nor would one skilled in the art be motivated to modify Villemure's reams in view of Ryan to include promotions on the paper wrappings as suggested by the Examiner.

Contrary to the Examiner's assertion, Villemure does not disclose reams with "a display surface for information and advertising." The display surface to which the Examiner refers is on a wall of the tubular sleeve that slides over the tower of packaged reams. Specifically, Villemure recites, "the full walls of the sleeve . . . provide a display surface for information and advertising which can be personalized for particular users or distributors." (Villemure, col. 5, lns. 51-56.) Villemure's tubular sleeve cannot correspond to the enclosure of claim 1 because the tubular sleeve does not enclose "a roll of paper or a plurality of unbound, stacked paper sheets," as required by claim 1. Rather, the tubular sleeve slides over the tower of packaged reams at the point of sale and surrounds four sides of the tower. Therefore, Villemure fails to disclose "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for" "a roll of paper or a plurality of unbound, stacked paper sheets," as recited in claim 1.

Moreover, one of ordinary skill in the art would not be motivated to modify Villemure's packaged reams in view of Ryan because Ryan teaches away from placing promotional material on Villemure's paper wrappings. Specifically, Ryan teaches away from placing promotional material on items when "the third party advertiser cannot exercise any control over who receives the message." (Ryan, col. 2, Ins. 65-66.) Thus, Ryan teaches away from placing promotional material on Villemure's paper wrappings because the advertiser cannot exercise any control over who receives the message. Rather, the message is received by random individuals who walk by the tower of stacked reams in a store and either notice the advertisement or purchase one of the reams. This is precisely the type of advertising Ryan's invention is designed to avoid. Accordingly, the Examiner's suggested modification of Villemure's paper wrappings contravenes one purpose of Ryan's invention—overcoming the disadvantage of conventional advertising campaigns in which "the third party advertiser has no assurance that a target audience would be reached." (Ryan, col. 2, In. 67 – col. 3, In. 1.) Therefore, one skilled in the art would not be motivated to modify Villemure's paper wrappings in view of Ryan.

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added). Moreover, and importantly in the present case, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would teach away from the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In this case, the Examiner has simply picked and chosen various elements from the prior art and put them together without consideration of operability or desirability. In doing so, the Examiner has ignored the teachings of Ryan and combined Ryan with Villemure in such a way that one purpose of Ryan's invention is thwarted.

The current rejection of claim 1 over the combination of Ryan and Villemure does not comply with Section 103(a) because (a) the applied art fails to disclose or suggest all

the features of this claim, and (b) one skilled in the art would not be motivated to modify Villemure's paper wrapping in view of Ryan. As explained above, Ryan teaches away from modifying Villemure's paper wrapping to include the features of claim 1. Accordingly, the Section 103(a) rejection of claim 1 should be withdrawn.

Claims 2-7 depend from claim 1. Accordingly, the Section 103(a) rejection of claims 2-7 should be withdrawn for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims.

Independent claims 11, 18, 22, 26, 31, 34, 49, 52, 57 and 61 have, *inter alia*, features generally analogous to those included in claim 1. Accordingly, the Section 103(a) rejection of claims 11, 18, 22, 26, 31, 34, 49, 52, 57 and 61 should be withdrawn for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims.

Claims 14, 16, 17, 20, 21, 23, 27, 29, 30, 32, 35-40, 43-45, 51, 53, 54, 58, 59 and 62-65 depend from one of the independent claims listed above. Accordingly, the Section 103(a) rejection of these claims should be withdrawn for at least the reasons discussed above with reference to their respective independent claims and for the additional features of these dependent claims.

B. Response to the Section 103(a) Rejection over Ryan, Villemure and Itkonen

Claims 8, 9, 24, 28, 42 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan, Villemure and Itkonen. Claims 8, 9, 24, 28, 42 and 56 depend from independent claims that have, *inter alia*, features generally analogous to those included in claim 1. Accordingly, claims 8, 9, 24, 28, 42 and 56 are patentable over Ryan and Villemure for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims. Moreover, Itkonen fails to cure the above-noted deficiencies of Villemure and Ryan to properly support a *prima facie* case of obviousness under Section 103(a). For example, Itkonen fails to disclose "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place

promotional material on an enclosure for" "a roll of paper or a plurality of unbound, stacked paper sheets," as recited in claim 1. Furthermore, Itkonen fails to provide a motivation to modify Villemure's paper wrapping to include promotional material from a third-party advertiser. To the contrary, Itkonen discloses placing the factory label on a plastic wrap for a paper roll. Accordingly, the Section 103(a) rejection of claims 8, 9, 24, 28, 42 and 56 should be withdrawn.

C. Response to the Section 103(a) Rejection over Ryan, Villemure and Crossman

Claims 10, 25, 33, 41, 55, 60 and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan, Villemure and Crossman. Claims 10, 25, 33, 41, 55, 60 and 64 depend from independent claims that have, *inter alia*, features generally analogous to those included in claim 1. Accordingly, claims 10, 25, 33, 41, 55, 60 and 64 are patentable over Ryan and Villemure for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims. Moreover, Crossman fails to cure the above-noted deficiencies of Villemure and Ryan to properly support a *prima facie* case of obviousness under Section 103(a). For example, Crossman fails to disclose "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for" "a roll of paper or a plurality of unbound, stacked paper sheets," as recited in claim 1. Furthermore, Crossman fails to provide a motivation to modify Villemure's paper wrapping to include promotional material from a third-party advertiser. To the contrary, Crossman discloses packaging having a detachable coupon compartment. Accordingly, the Section 103(a) rejection of claims 10, 25, 33, 41, 55, 60 and 64 should be withdrawn.

D. Response to the Section 103(a) Rejection over Ryan, Villemure and Loeb

Claims 12, 13, 15, 19, 46, 47 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan, Villemure and Loeb. Claims 12, 13, 15, 19, 46, 47 and 50 dependent from independent claims that have, *inter alia*, features generally analogous to those included in claim 1. Accordingly, claims 12, 13, 15, 19, 46, 47 and 50 are patentable over Ryan and Villemure for at least the reasons discussed above with reference to claim 1

and for the additional features of these claims. Moreover, Loeb fails to cure the above-noted deficiencies of Villemure and Ryan to properly support a *prima facie* case of obviousness under Section 103(a). For example, Loeb fails to disclose "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for" "a roll of paper or a plurality of unbound, stacked paper sheets," as recited in claim 1. Furthermore, Loeb fails to provide a motivation to modify Villemure's paper wrapping to include promotional material from a third-party advertiser. To the contrary, Loeb discloses that 60% of all new subscriptions are acquired by third-party service providers known as agents. Accordingly, the Section 103(a) rejection of claims 12, 13, 15, 19, 46, 47 and 50 should be withdrawn.

E. Previously Filed Declaration of Commercial Success

Applicant filed a Declaration of Commercial Success ("Declaration") on November 28, 2005. In the Office Action, the Examiner notes that due to poor scanning the Examiner was unable to view Exhibit A of the Declaration. As such, applicant encloses herewith a copy of the previously filed Declaration including Exhibits A and B.

In the Office Action, the Examiner asserted, "Applicant's arguments filed 11/28/2005 with respect to commercial success have been fully considered but they are not persuasive." (P. 9.) Specifically, the Examiner stated, "Applicant's Exhibit B shows gross sales figures, however, the Applicant did not give any evidence of company market share or what sales would normally be expected in the market." (Office Action, p. 11.)

MPEP Section 716.03(b) recites, "[g]ross sales figures do not show commercial success absent evidence as to market share, [citation omitted], or as to the time period during which the product was sold, or as to what sales would normally be expected in the market." (Emphasis added.) Thus, the MPEP requires evidence as to either (a) market share, (b) the time period during which the product was sold, or (c) what sales would normally be expected in the market. Although the Declaration did not include information as to market share, the Declaration included (a) information as to the time period during

which the product was sold (e.g., paragraph 4 states that the product was sold between July 17, 2005 and September 25, 2005), and (b) information as to what sales would normally be expected in the market (e.g., paragraph 4 states that before the claimed invention was sold, the average number of cartons shipped each week was 1,933). Because the Declaration complies with the requirements of the MPEP, the gross sales figures are evidence of commercial success.

In the Office Action, the Examiner further remarked that (a) on several high volume weeks "prior to Applicant's claimed invention, the average number of cartons shipped to Costco was higher than the average number of cartons shipped to Costco" during several low volume weeks after introduction of the invention, and (b) "there were whole months previous 7/15/05 that more cartons were shipped to Costco than cartons shipped after 7/17/05." (Pp. 11 and 12.) The undersigned attorney notes that the sales of cartons of paper vary on a weekly and monthly basis due to numerous factors. Therefore, picking and choosing weeks with a high sales volume before introduction of the invention and weeks with a low sales volume after introduction of the invention does not accurately illustrate the effect of the invention on sales. Because of the inherent variability in sales over short periods of time, a more accurate depiction of a trend in sales includes examining averages. Even after manipulating the data in a manner disfavorable to the applicant, the Examiner concedes that the claimed invention resulted in a 28% increase in sales. This increase alone is sufficient to warrant a finding of commercial success.

In light of the foregoing, the Declaration shows a nexus between commercial success and the claimed invention. As a result, the Examiner should accord proper patentable weight to the Declaration.

F. Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the applied art. The applicant accordingly requests reconsideration of the application and a Notice of Allowance. If the Examiner has any questions or believes a

telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact David Dutcher at (206) 359-6465.

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Respectfully submitted,

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